Remarks

Claims 1 to 49 are pending. Claims 50 to 56 and 67-74 have been canceled. Claims 50 to 66 have been withdrawn from consideration without prejudice or disclaimer to their respective underlying subject matters. Claims 1, 2, 8, 9, 38, 40, and 41 are amended.

Election/Restriction

In light of the final restriction requirement, Group II (claims 57-66) and Group III (claims 50-56) are hereby cancelled and withdrawn from consideration without prejudice or disclaimer to their respective underlying subject matters.

Drawings

Applicants appreciate that the proposed drawings filed on February 21, 2003 have been approved. Formal drawings have been mailed in.

Double Patenting

Applicants note the various provisional double patenting rejections and provisional obviousness-type rejections, but will not address such rejections until claims from the co-pending patent applications are allowed or issued.

§ 102 Rejections

Claims 1-7, 25-38, 40, 41 and 48-49 stand rejected under 35 USC § 102(a) as being anticipated by Garber et al. (U.S. Pat. No. 6,232,870).

Claims 1-7: Independent claim 1 has been amended to recite in step b) "using the RFID reader to interrogate at least one RFID tag associated with an item of interest to obtain information associated with the item of interest, wherein the item of interest is not currently associated with the category selected in step (a)," and amended to recite in step c) "thereafter associating information related to the at least one item obtained in step (b) with the category selected in step (a)." Support for this amendment can be found in the specification, for example

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on page 3, lines 25-33, and on page 4, lines 1-8. In addition, dependent claim 2 has been amended to recite the step of saving the categorized information obtained in step (c) in a database. Support for these amendment can be found in the specification, for example on page 3, lines 27-31.

Applicants believe independent claim 1, as amended, is allowable over Garber et al. Garber et al. does not disclose the steps of: (a) *selecting a category* of items using a user interface associated with an RFID reader; (b) using the RFID reader to interrogate at least one RFID tag associated with an item of interest to obtain information associated with the item of interest, *wherein the item of interest is not currently associated with the category selected in step (a)*; and (c) thereafter *associating information related to the at least one item obtained in step (b) with the category selected in step (a)*. One non-limiting example of the method steps recited in claim 1 is illustrated in the specification starting on page 3, line 33 to page 4, line 3. In this example, a user in a library may select or define a category for "used inside library but not checked out," then interrogate RFID tags associated with items left by users inside the library, and then save that information within the "in-house use" category on a database. If the user then wishes to change categories, the user may select or define another category ("used in children's reading room," for example), and then interrogate items and save them within that category on a database.

In contrast, Garber et al. teaches a variety of functions, methods and applications, for example starting on column 16, lines 32 and ending on column 18, lines 54, *where the item of interest's category does not change* based on the function, method or application performed. For example, Garber et al. teaches that a device could be programmed with specific information identifying certain items that an operator wishes to locate. As the identifier of, for example, items on a shelf were read by the RF reader, each would be compared, with the list of times stored in memory, and if a match occurred, the device would then create a signal indicating the presence of the missing item. (See column 16, line 36 to column 17, line 16 of Garber et al.) As another example, Garber et al. teaches that the RFID device could also be used to verify the order of the materials on a shelf. For example, the RFID device is scanned across one or more rows of items, the device reads each item, and indicates, to the operator, which items are not shelved in the correct order. (See column 17, lines 17-26 of Garber et al.) As another example, Garber et al. teaches a method where the operator can use the hand-held RFID device to locate items that

are in the wrong location. In a preferred embodiment, the shelf location for an item is encoded

directly in the RFID tag memory for that item. In one embodiment, the correct shelf location is

obtained by reading several RFID tags and heuristically processing the data to infer a location.

For example, if the RFID device reads a certain number of tags that are indexed to the Adult

fiction area, the device can be programmed to alert the user when non-Adult Fiction items are

encountered. Alternatively, in another embodiment, the library may place "location tags" on the

shelves or other locations to be searched. These location tags are first read by the hand-held

device to indicate that subsequent items read should belong to that location and an alert is

provided when a mismatch occurs. (See column 17, lines 27-60 of Garber et al.) As another

example, Garber et al. teaches that the hand-held RFID device may be used to enter data into the

device as to a specific item. For example, when a user takes a library material from its location,

the user may input the new status of the article into the hand-held RFID device. (See column 17,

line 61 to column 18, line 6 of Garber et al.) As yet another example, Garber et al teaches that

the hand-held device could be used to provide additional information about a specific item once

the item has been obtained and its RFID tag scanned by the RFID device. For example, the

library staff may collect materials that have been used in the library, and scan those materials

either to obtain more information about that material (who last checked it out; how often has it

been used) or to provide information to a database that generates statistical profiles of library

material usage, or both. The operator can also indicate from where the items were collected by

selecting from a list of locations, entering a location code or reading a "location RFID Tag" that

is associated with that location and would preferably be affixed to or near that location. In this

way, the library staff is able to obtain additional information about where in the library such

materials were used. (See column 18, lines 7-28 of Garber et al.)

As a result, Garber et al. does not teach a function, method, or application where a user is

seeking to make an association between a new category and some item of interest that is not

currently associated with that category, and thereafter associates the information related to the

item of interest with the new category selected.

Therefore, Garber et al. does not teach all of the steps recited in claim 1, which are as follows:

(a)   selecting a category of items using a user interface associated with an RFID reader;

(b)   using the RFID reader to interrogate at least one RFID tag associated with an item of interest to obtain information associated with the item of interest, wherein the item of interest is not currently associated with the category selected in step (a); and

(c)   thereafter associating information related to the at least one item obtained in step (b) with the category selected in step (a).

Moreover, Applicants note that the Examiner only relied on the text of issued claim 1 of Garber et al. to support the rejection of claim 1 in the current Office Action, which is not sufficient under the current law. MPEP §2131 states: "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently describe in a single prior art reference," *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). ...The identical invention must be shown in as complete detail as contained in the ...claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226,1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Claim 1 of the present application did not match the issued claim 1 of Garber, and without more explanation, there is insufficient support for an anticipation rejection. Therefore, the rejection is unsupported by the art and should be withdrawn.

Lastly, claim 2 has been amended to clarify that the categorized information obtained in step (c) is saved in a database. Support for this amendment can be found in the specification, for example on page 3, lines 27-31.

Thus, claim 1, as amended, recites elements not disclosed by Garber et al. and should be allowable. Claims 2-7, which depend from claim 1 and add further limitations, should also now be allowable. Therefore, Applicants respectfully request the rejection of claims 1-7 under 35 U.S.C. § 102(a) over Garber et al. be withdrawn.

Claims 25-31: First, in regard to claim 25, the support for the anticipation rejection in the Office Action is portions of issued claims 11 and 14 of Garber, which is not sufficient under the current law. MPEP §2131 states: "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently describe in a single prior art reference."

Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). ...The identical invention must be shown in as complete detail as contained in the ...claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226,1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Claim 25 of the present application did not match the issued claims 11 and 14 of Garber, and without more explanation, there is insufficient support for an anticipation rejection. Therefore, the rejection is unsupported by the art and should be withdrawn.

Second, Garber does not teach the method of claim 25. Claim 25 recites a method of identifying items associated with RFID tags, comprising the steps of:

(a)   providing a database including entries associated with certain items;

(b)   interrogating RFID tags associated with items; and

(c)   providing an indication to a user when an RFID tag associated with an item that is not on the database is interrogated.

One non-limiting example of the method steps recited in claim 25 is illustrated in the specification starting on page 5, lines 5 to 14. For example, during data collection, the RFID reader may provide audible and/or visual feedback to indicate when the RFID reader detects an RFID tag that does not match an entry on an existing database. For example, a lighted indicator may indicate that an RFID tag has been interrogated that does not match an entry on an existing database of items. The benefit of this feature is to alert a user when an article, for example a book, is interrogated and the book is not found on the library's database of books, and thus, the book might be from another library, or for some other reason, it is not recorded on their database system. Understandably, it is important that your database is complete in that it includes your entire inventory of books or items and that they be properly recorded. Otherwise, you might have books or items in your library that are not recorded properly in the system.

In contrast, Garber teaches a variety of functions, methods and applications, for example starting on column 16, lines 32 and ending on column 18, lines 54 (many of which are included above in the section on claims 1-7), where there is no teaching of interrogating an item that is *not on the database* and then *indicating* a user of that fact. Instead, Garber only teaches interrogating items that are already recorded on the database and then performing various functions, methods and applications referenced above. Therefore, the rejection is unsupported by the art and should be withdrawn.

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Thus, claim 25 recites elements not disclosed by Garber et al. and should be allowable. Claims 26-31, which depend from claim 25 and add further limitations, should also be allowable. Therefore, Applicants respectfully request the rejection of claims 25-31 under 35 U.S.C. § 102(a) over Garber et al. be withdrawn.

Claims 32-36: Claims 32-36 have been canceled without prejudice to their underlying subject matter, rendering the present rejection moot.

Claim 38: Claim 38 was amended to help clarify that the information obtained in step (a) is used for the second purpose in step (b), which is supported by the specification, for example on page 7, lines 4 to 25. Applicants believe claim 38, as amended, is allowable over Garber et al. for the following reasons.

First, in regard to claim 38, the support for the anticipation rejection in the Office Action is portions of issued claims 11 and 14 of Garber, which is not sufficient under the current law. MPEP §2131 states: "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently describe in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). ...The identical invention must be shown in as complete detail as contained in the ...claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226,1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Claim 38 of the present application did not match the issued claims 11 and 14 of Garber, and without more explanation, there is insufficient support for an anticipation rejection. Notably, in section 13 of the Office Action, the Examiner admits that Garber et al. does not teach using the information obtained for determining the presence or absence of the items in the storage area, as recited in claim 38. Therefore, the rejection is unsupported by the art and should be withdrawn.

Second, Garber does not teach the method of claim 38. Claim 38 recites a method of obtaining information related to items of interest associated with RFID tags, comprising the steps of:

    (a)   interrogating RFID tags, each associated with an item, to obtain information related to the items for a purpose other than determining the presence or absence of the items in a storage area; and
    (b)   using the information for determining the presence or absence of the items in the storage area.

One non-limiting example of the method steps recited in claim 38 is illustrated in the specification starting on page 7, lines 4 to 25:

> In another embodiment of the present invention, For example, inventory may be conducted simultaneously with other operations of the RFID system. That is, it is known to conduct inventory of RFID-tagged items by interrogating the items for that purpose. In this embodiment of the present invention, inventory is conducted as a background operation of the RFID system, using data acquired for a different purpose. For example, a portable RFID reader may be used to interrogate items in a storage area to determine whether they are located in the proper order, location, or both, or whether they are present on a list of items in which the user is interested. This would be the primary purpose of the RFID interrogation, but the information obtained regarding those items may also be used to conduct inventory. That is, each RFID-tagged item that is interrogated to determine whether it is in the proper order relative to adjacent items is necessarily also present in the storage area, and thus an inventory database can be consulted and updated, as needed, to reflect the fact that the item is present. This background inventory operation may also be used with other RFID hardware, such as check-in/check-out devices, conversion stations (for converting items without RFID tags to items with RFID tags, the tags being associated with the items), or other such devices. In those instances, the primary operation may be to check an item into or out of a storage area, or to convert an item to an RFID-tagged item, but inventory (the secondary operation) can also be conducted in the background, perhaps to notify a user if the items presented for conversion are not presented in the expected order according to an order list of items.

In contrast, Garber teaches a variety of functions, methods and applications, for example starting on column 16, lines 32 and ending on column 18, lines 54 (many of which are included above in the section on claims 1-7) where there is no teaching of performing multiple operations, using the same information that is collected to determine for a purpose other than determining the presence or absence of the items in a storage area to conduct inventory (i.e. determining the presence or absence of items). Therefore, the rejection is unsupported by the art and should be withdrawn.

Claim 40: Claim 40 was amended to help clarify that the information obtained in step (a) is used for the second purpose in step (b), which is supported by the specification, for example on page 7, lines 4 to 25. Applicants believe claim 40, as amended, is allowable over Garber et al. for the following reasons.

First, in regard to claim 40, the support for the anticipation rejection in the Office Action is portions of issued claims 1 and 2 of Garber, which is not sufficient under the current law. MPEP §2131 states: "A claim is anticipated only if each and every element as set forth in the

claim is found, either expressly or inherently describe in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). ...The identical invention must be shown in as complete detail as contained in the ...claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226,1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Claim 40 of the present application did not match the issued claims 1 and 2 of Garber, and without more explanation, there is insufficient support for an anticipation rejection. Notably, in section 13 of the Office Action, the Examiner admits that Garber et al. does not teach using the information obtained for a second purpose of determining the presence or absence of the items in the storage area, as recited in claim 40. Therefore, the rejection is unsupported by the art and should be withdrawn.

Second, Garber does not teach the method of claim 40. Claim 40, as amended, recites a method of obtaining information related to items of interest associated with RFID tags, comprising the steps of:

(a) interrogating RFID tags, each associated with an item, to determine information related to the items for a first purpose of searching for certain items on a predetermined search list; and

(b) using the information obtained in step (a) for a second purpose of determining the presence or absence of the items in the storage area.

One non-limiting example of the method steps recited in claim 40 is illustrated in the specification starting on page 7, lines 4 to 25, which is above in the section on claim 38.

In contrast, Garber teaches a variety of functions, methods and applications, for example starting on column 16, lines 32 and ending on column 18, lines 54 (many of which are included above in the section on claims 1-7) where there is no teaching of performing multiple operations, using the same information that is collected for a first purpose of searching for certain items on a predetermined search list to conduct inventory (i.e. determining the presence or absence of items). Therefore, the rejection is unsupported by the art and should be withdrawn.

Claim 41: Claim 41 was amended to help clarify that the information obtained in step (a) is used for the second purpose in step (b), which is supported by the specification, for example on page 7, lines 4 to 25. Applicants believe claim 41, as amended, is allowable over Garber et al. for the following reasons.

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First, in regard to claim 41, the support for the anticipation rejection in the Office Action is portions of issued claims 1 and 2 of Garber, which is not sufficient under the current law. MPEP §2131 states: "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently describe in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). ...The identical invention must be shown in as complete detail as contained in the ...claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226,1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Claim 41 of the present application did not match the issued claims 1 and 2 of Garber, and without more explanation, there is insufficient support for an anticipation rejection. Notably, in section 13 of the Office Action, the Examiner admits that Garber et al. does not teach using the information obtained for determining the presence or absence of the items in the storage area, as recited in claim 41. Therefore, the rejection is unsupported by the art and should be withdrawn.

Second, Garber does not teach the method of claim 41. Claim 41 recites a method of obtaining information related to items of interest associated with RFID tags, comprising the steps of:

    (a)   interrogating RFID tags, each associated with an item, to determine information related to the items for a first purpose of checking items into or out of a storage area; and

    (b)   using the information obtained in step (a) for a second purpose of determining the presence or absence of the items in the storage area.

One non-limiting example of the method steps recited in claim 41 is illustrated in the specification starting on page 7, lines 4 to 25, which is above in the section on claim 38.

In contrast, Garber teaches a variety of functions, methods and applications, for example starting on column 16, lines 32 and ending on column 18, lines 54 (many of which are included above in the section on claims 1-7) where there is no teaching of performing multiple operations, using the same information that is collected to for a first purpose of checking items into or out of a storage area to conduct inventory (i.e. determining the presence or absence of items). Therefore, the rejection is unsupported by the art and should be withdrawn.

Claim 48: First, in regard to claim 48, the support for the anticipation rejection in the Office Action is portions of issued claims 6 and 7 of Garber, which is not sufficient under the current law. MPEP §2131 states: "A claim is anticipated only if each and every element as set

forth in the claim is found, either expressly or inherently describe in a single prior art reference."

Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed.

Cir. 1987). ...The identical invention must be shown in as complete detail as contained in the

...claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226,1236, 9 USPQ2d 1913, 1920 (Fed.

Cir. 1989). Claim 48 of the present application did not match the issued claims 6 and 7 of

Garber, and without more explanation, there is insufficient support for an anticipation rejection.

Therefore, the rejection is unsupported by the art and should be withdrawn.

Second, Garber does not teach the method of claim 48. Claim 48 recites a method of collecting data related to items associated with RFID tags, comprising the steps of:

(a)   using an RFID reader to interrogate RFID tags, each associated with an item, wherein the items are not arranged or interrogated in an order associated with their desired locations in a storage area;

(b)   organizing information obtained from the RFID tags in an order associated with the desired locations of the items in a storage area; and

(c)   providing the organized information from step (b) to a user.

One non-limiting example of the method steps recited in claim 48 is illustrated in the specification starting on page 9, lines 8 to 27:

> In libraries and other storage areas, considerable effort can be expended returning items to a storage area after use. These items generally must be put back into the proper location. Often this is done by manually sorting the items onto a cart, then traversing the storage area, taking the ordered items from the cart and replacing them on, for example, the shelves of the storage area. Automated assistance for this task is the purpose of the following embodiment of the present invention. In this embodiment, a portable RFID reader can be used to read the RFID tags associated with each of a set of randomly placed items and display a list of those items according to a predetermined order. The order may be a standard order for organizing items of that type (such as the Dewey Decimal system or the Library of Congress system for organizing materials in a library), or a customized order. When the RFID reader interrogates the random set of RFID-tagged items, the reader can organize information about those items in order, and then display either a part of or all of the list of ordered items. The information displayed in the list could be information obtained from the interrogated RFID tags, information obtained from a database, or a combination thereof. The list could be used to place the items in a storage area in the proper order, as with reshelving a group of library materials in their appropriate locations, or for placing the items on a cart for transportation to a storage area. The invention facilitates the placement of the items on the cart in the desired order, to make replacement of the items on the storage area shelves more efficient.

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In contrast, Garber teaches a variety of functions, methods and applications, for example starting on column 16, lines 32 and ending on column 18, lines 54 (many of which are included above in the section on claims 1-7) where there is no teaching of interrogating items not arranged in a particular order, organizing the information obtained in an order associated with their desired locations of the items in a storage area, and then providing the organized information to a user. Therefore, the rejection is unsupported by the art and should be withdrawn.

The rejection of claims 1-7, 25-38, 40, 41 and 48-49 under 35 USC § 102(a) as being anticipated by Garber et al. have been overcome and should be withdrawn.

§ 103 Rejections

Claims 8-17 and 67-74 stands rejected under 35 USC § 103(a) as being unpatentable over Garber et al. and Wishneusky et al.

Claims 8-17: First, Applicants respectfully submit that the Examiner has not made out a prima facie case of obviousness based on Garber et al. and Wishneusky et al. because teachings the Examiner relied upon from the references are only issued claim 1 from Garber et al. and issued claim 9 from Wishneusky et al., and without more explanation, there is insufficient support for an obviousness rejection. Moreover, obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive support the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). The present Office Action does not include explain why it would have been obvious combine the functions, methods and applications of RFID described in Garber et al. with the multi-channel data communications controller described in Wishneusky et al., which is directed towards transmitting and receiving serial data bits, since they are completely unrelated. Therefore, the rejection is unsupported and should be withdrawn.

Second, independent claim 8 has been amended to recite in step b) "using the RFID reader to interrogate at least one RFID tag associated with an item of interest to obtain information associated with the item of interest, wherein the item of interest is not currently associated with the category selected in step (a)," and amended to recite in step c) "thereafter categorizing information related to the at least one item(s) associated with the interrogat d RFID

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tag(s) obtained in step (b) in at least one of the categories." Support for this amendment can be found in the specification, for example on page 3, lines 25-33, and on page 4, lines 1-8. In addition, dependent claim 9 has been amended to recite the step of saving the categorized information obtained in step (c) in a database. Support for these amendment can be found in the specification, for example on page 4, lines 10-19.

Applicants believe independent claim 8, as amended, is allowable over Garber et al. in view of Wishneusky et al. Garber et al. does not disclose the steps of: (a) *selecting at least two categories* of items using a user interface associated with an RFID reader; (b) using the RFID reader to interrogate at least one RFID tag associated with an item of interest to obtain information associated with the item of interest, *wherein the item of interest is not currently associated with the category selected in step (a)*; and (c) thereafter *categorizing information related to the at least one item(s) associated with the RFID tag(s) obtained in step (b) in at least one of the categories selected in step (a)*. One non-limiting example of the method steps recited in claim 8 is illustrated in the specification starting on page 4, lines 10-19. In this example, a user uses an RFID reader to interrogate at least one RFID-tagged item, and then to associate that item with one or more of the categories. That is, categories may be created for different types of items, or for items having a different inventory status (present and absent, for example), or for items that have been recently interrogated (and thus may be a frequently used item) or not. The RFID-tagged items may be categorized in none, one, or more than one of the categories, depending on whether or not each item has the attributes of the items to be categorized in each respective category. The categories may be mutually exclusive (meaning that every RFID-tagged item may be categorized in only one category) or not. Likewise, Wishneusky et al., does not show, teach, or suggest the steps of: (a) selecting at least two categories of items using a user interface associated with an RFID reader; (b) using the RFID reader to interrogate at least one RFID tag associated with an item of interest to obtain information associated with the item of interest, wherein the item of interest is not currently associated with the category selected in step (a); and (c) thereafter categorizing information related to the at least one item(s) associated with the RFID tag(s) obtained in step (b) in at least one of the categories selected in step (a). Instead, Wishneusky et al. is included only for its teaching of categorizing each received data character into one of a selected categories.

In contrast, Garber et al. teaches a variety of functions, methods and applications, for example starting on column 16, lines 32 and ending on column 18, lines 54, *where the item of interest's category does not change* based on the function, method or application performed, as discussed in reference to claims 1-7 above.

Thus, independent claims 8, as amended, recite elements not shown, taught, or suggested by the cited references, whether taken alone or in combination, and should be allowable. Claims 9-17, which depend from claim 1 and add further limitations, should also now be allowable. In summary, the rejection of claims 8-17 under 35 USC § 103(a) as being unpatentable over Garber et al. and Wishneusky et al. has been overcome and should be withdrawn.

<u>Claim 67-74</u>: Claims 67-74 have been canceled without prejudice to their underlying subject matter, rendering the present rejection moot.

In summary, the rejection of claims 8-17 and 67-74 under 35 USC § 103(a) as being unpatentable over Garber et al. and Wishneusky et al. has been overcome and should be withdrawn.

<u>Claims 18-24</u>: Applicants respectfully submit that the Examiner has not made out a prima facie case of obviousness based on Garber et al. in view of Wishneusky et al. and Harrison because teachings the Examiner relied upon from the references are only issued claim 1 from Garber et al., issued claim 9 from Wishneusky et al., and without more explanation, there is insufficient support for an obviousness rejection. Moreover, obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive support the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). The present Office Action does not include explain why it would have been obvious combine the functions, methods and applications of RFID described in Garber et al. with the multi-channel data communications controller described in Wishneusky et al., which is directed towards transmitting and receiving serial data bits, since they are completely unrelated, and then combine it with Harrison, which relates to a system for identifying multiple electronic tags. Therefore, the rejection is unsupported and should be withdrawn.

Second, even if all three references were somehow combined, they would not produce the method of claim 18. Claim 18 recites a method of interrogating RFID tags associated with items of interest, comprising the steps of:

(a)   selecting at least one category of items using a user interface associated with an RFID reader;

(b)   interrogating RFID tags associated with items, at least one of which is within the category of items;

(c)   categorizing information related to the at least one item(s) associated with the interrogated RFID tag(s) in at least one of the categories; and

(d)   ignoring any RFID-tagged-item that may not be categorized in at least one category.

One non-limiting example of the method steps recited in claim 18 is illustrated in the specification starting on page 4, lines 21 to 33:

> A third way of categorizing RFID-tagged items is to select at least one category of items; interrogate RFID tags associated with items, at least one of which is within the category of items; and associate the RFID-tagged items with the appropriate category. That is, the RFID reader would associate items that have certain attributes with a certain category, and ignore any item that does not have those attributes. Thus if a user were only interested in items having certain characteristics, the RFID reader could create a list of only those items, without listing or categorizing any other items that didn't have the specified characteristics. For example, if a user in a library were only interested in obtaining information from items of a certain type, such as reference texts, a category for reference texts could be created, RFID-tagged items interrogated, and only reference texts categorized in that category. The information necessary to categorize each RFID-tagged item (in this and other embodiments) may be obtained from the RFID tag itself, or from a database that includes a record related to that RFID tag and/or the item...

In contrast, Garber teaches a variety of functions, methods and applications, for example starting on column 16, lines 32 and ending on column 18, lines 54 (many of which are included above in the section on claims 1-7), where there is no teaching of ignoring any RFID-tagged-item that may not be categorized in at least one category. Instead, Garber only teaches interrogating items that are already recorded on the database and then performing various functions, methods and applications referenced above.

Likewise, Wishneusky et al., does not show, teach, or suggest the steps of ignoring any RFID-tagged-item that may not be categorized in at least one category. Instead, Wishneusky et

al. is included only for its teaching of categorizing each received data character into one of a selected categories.

In regard to Harrison, the Office Action stated that Harrison teaches that if a tag identification number is detected which is not associated with any semantics, the program can ignore the tag. Applicants disagree. Harrison teaches the matching of a tag identification number to a specific function to be performed by a computer such as "to unlock an electronically controlled door, to display a graphical image on a computer display, or login into a computer network, etc." (See Column 10, Lines 13-37 of Harrison.) "After an electronic tag is read, the computer system 12 is used to interpret the identification number of the electronic tag and provide the requested digital service. Semantic binding of the identification number can be provided by a computer 14 ..." (See, Column 9, Lines 1-8 of Harrison.) "For example, a database format can be constructed in which each identification number of an electronic tag is a database key. Associated with that key is a set of digital actions to undertake when that identification number of an electronic tag is detected. There is an enumerated list of such actions – display a Web page, display a text document, display a date in a calendar, go to a certain location in a document, and so forth." (See, Column 9, Lines 28-35 of Harrison.) Therefore, it is clear that the segment of Harrison cited by the examiner does not teach that if an item to which an RFID tag is attached cannot be categorized into one of the categories that the operator has selected, that the act of categorizing the item can be ignored, as recited in claim 18. The teaching of Harrison to ignore an ID tag if there is no mapped computer command does not, can not teach that when one is categorizing items, that if an item does not fit into one of the categories into which a user is categorizing items, that the user need not categorize the item.

Thus, claim 18 recites elements not disclosed by Garber et al., Wishneusky et al., and Harrison, whether taken alone or combined, and should be allowable. Claims 19-24, which depend from claim 18 and add further limitations, should also be allowable. Therefore, Applicants respectfully request the rejection of claims 18-224 over Garber, Wishneusky, and Harrison et al. has been overcome and should be withdrawn.

Claim 39: First, Applicants respectfully submit that the Examiner has not made out a prima facie case of obviousness based on Garber et al. in view of Boley et al. because the only support for such a rejection is portions of issued claims 6 and 7 of Garber and portions of issued

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claims 1 and 8 of Boley, which is not sufficient under the current law. Claim 39 of the present

application did not match the issued claims 6 and 7 of Garber and potions of issued claims 1 and

8 of Boley, even if somehow combined, and without more explanation, there is insufficient

support for this obviousness rejection. Therefore, the rejection is unsupported by the art and

should be withdrawn.

Second, even if Garber et al. and Boley et al. where somehow combined, the combination

does not teach the method of claim 39. Claim 39 recites a method of obtaining information

related to items of interest associated with RFID tags, comprising the steps of:

(a)   interrogating RFID tags, each associated with an item, to obtain information for a
        first purpose of determining whether the items are in a predetermined order within
        a storage area; and

(b)   using information obtained in step (a) for a second purpose of determining the
        presence or absence of the items in the storage area.

One non-limiting example of the method steps recited in claim 39 is illustrated in the

specification starting on page 7, lines 4 to 25, which is reproduced above in the section on claim

38.

In contrast, Garber teaches a variety of functions, methods and applications, for example

starting on column 16, lines 32 and ending on column 18, lines 54 (many of which are included

above in the section on claims 1-7) where there is no teaching of performing multiple operations,

using the same information that is collected to determine whether the items are in a

predetermined order within the storage area to conduct inventory (i.e. determining the presence

or absence of items). Likewise, Boley et al. does not teach performing multiple operations, using

the same information that is collected to determine whether the items are in a predetermined

order within the storage area to conduct inventory (i.e. determining the presence or absence of

items). Therefore, the rejection is unsupported by the art and should be withdrawn.

Claim 42-47: First, Applicants respectfully submit that the Examiner has not made out a

prima facie case of obviousness based on Garber et al. in view of Boley et al. because the only

support for such a rejection is portions of issued claims 6 and 7 of Garber and portions of issued

claims 1 and 8 of Boley, which is not sufficient under the current law. Claims 42 and 45 of the

present application did not match the issued claims 6 and 7 of Garber and potions of issued

claims 1 and 8 of Boley, even if somehow combined, and without more explanation, there is

insufficient support for this obviousness rejection. Therefore, the rejection is unsupported by the art and should be withdrawn.

Second, there is no mention whatsoever in section 13 of the Office Action about where Garber et al. or Boley et al. show, teach, or suggest the elements of claims 42 and 45. Instead, section 13 of the Office Action seems directly solely at claim 39, which includes steps of determining whether the items are in a predetermined order within a storage area. In contrast, claims 42 and 45 are directed at:

(a) using an RFID reader to interrogate at least one RFID tag associated with an item;

(b) determining whether the item is represented on the inventory list as being present, and if not;

(c) indicating to a user in real time that the inventory list indicates that the item is absent; and

(d) enabling the user in real time to confirm that the item is present using a user interface associated with the RFID reader.

or

(a) using an RFID reader to interrogate RFID tags each associated with an item;

(b) determining whether an item represented on the inventory list as being present is among the items whose RFID tags were interrogated, and if not;

(c) indicating to a user in real time that the inventory list indicates that the item is present; and

(d) enabling the user in real time to confirm that the item is absent using a user interface associated with the RFID reader.

Some non-limiting examples of the method steps recited in claims 42 and 45 are illustrated in the specification starting on page 8, lines 9 to 34:

> In a related embodiment of the invention, a portable RFID reader performs real-time inventory reconciliation. That is, the portable RFID reader reads the RFID tags of items located in a storage area, such as on a shelf, and then compares the list of items detected with the expected contents of the storage area based on data stored in an inventory database. An inventory database may be stored on a removable data storage device, such as a flash memory card, or may be stored in memory that is part of the portable RFID reader, or in a database that is accessible by a wireless connection or otherwise in real time. These inventory databases may be separate from a master inventory database that is stored on a central computer, network, or the like, which can be updated by the real-time database continuously or intermittently. Real time inventory information can be provided to a user regarding items that should have been found but were not, items that should not have been found but were, or other discrepancies between the actual inventory and the inventory reflected on the database. The status of an item could be updated based on the information obtained from the interrogation, and the new status could be stored in the

inventory database. A particularly useful feature of real-time inventory is for the RFID reader to enable the user to confirm, during interrogation, that a particular item that was not found (but was expected to have been found) is missing from the storage area. If the user confirms that the item is missing, then the RFID reader can correct the inventory database to indicate that the item is missing (that is, not present). The reverse may also be useful – enabling the user to confirm that a particular item that was found but was thought to be missing is actually present, and thus to correct the inventory database. The corrected inventory database may be stored wherever the original inventory database was stored. This real-time reconciliation of inventory saves time, and thus is a useful feature in inventory work.

Accordingly, the applied rejection is believed to be faulty, and if the Examiner proposes to provide any reasoning supporting the rejection then Applicants respectfully request a second non-final Office Action be issued so that Applicants may learn what that reasoning is and reply to it. Since claims 42 and 45 are supported by the Office Action, claims 43-44 and 46-47, which depend from claims 42 and 45 are also unsupported. Therefore, since the rejection is unsupported by the Office Action and thus, defective, the rejection should be withdrawn.

Therefore, Applicants respectfully request the rejection of claims 42-47 under 35 U.S.C. § 103(a) over Garber et al. in view of Boley et al. be withdrawn.

In summary, the rejection of claims 39, 42-47 under 35 USC § 103(a) as being unpatentable over Garber in view of Boley has been overcome and should be withdrawn.

In view of the above, it is submitted that the application is in condition for allowance. Reconsideration of the application is requested.

Respectfully submitted,

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Date

By: _Melissa E. Buss_
Melissa E. Buss, Reg. No.: 47,465
Telephone No.: (651) 733-0649

Office of Intellectual Property Counsel
3M Innovative Properties Company
Facsimile No.: 651-736-3833

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